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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,500	02/21/2001	Guillermo Lao	111325-40	6754
22204	7590	07/12/2006	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			ALLEN, WILLIAM J	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/788,500	Applicant(s) LAO ET AL.	
	Examiner William J. Allen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/17/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 147-249 is/are pending in the application.
- 4a) Of the above claim(s) 150-152, 154, 158-194, 196-198, 202-204, 206, 210-246, and 248 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 147-149, 153, 155-157, 195, 199-201, 205, 207-209, 247 and 249 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/17/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

Claims 150-152, 154, 158-194, 196-198, 202-204, 206, 210-246, and 248 have been withdrawn.

Claims 147-249 are pending with claims 147-149, 153, 155-157, 195, 199-201, 205, 207-209, 247, and 249 are rejected as set forth below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 147-149, 153, 155-157, 195, 199-201, 205, 207-209, 247, and 249 are rejected under 35 U.S.C. 103(a) as being unpatentable over the public use of the invention by iUniverse as demonstrated by the periodicals listed as PTO 892 references U, V, W, X, and Y (herein referred to as 892u, 892v, 892w, 892x, and 892y respectively).**

Regarding claim 147, 892u-892y teach:

receiving, by a publishing system, a selection of content from a user of said publishing system, said selection identifying an item of content (see at least: 892u 8, 11; 892v 4, 9, 12-14; 892w Pages 2-3, 7-15; 892x 7, 11);

receiving, by a publishing system, a request to publish the selected content from the user of said publishing system (see at least: 892u 8, 11; 892v 4, 9, 12-14; 892w Pages 2-3, 7-15; 892x 7, 11);

providing, by said publishing system in response to the request from the user to publish content, information to a distributor system, and information comprising at least one of a description of the content, metadata of the content, content identifiers, publisher information, content repository indication and rights specification identifier (see at least: 892u 8; 892v 12-14; 892w Page 8; 892x 7); The Examiner notes that iUniverse acts as both a publishing system and distribution system and transfers the user provided information accordingly;

upon receiving the information, generating by said distributor system a response using said provided information an one or more pre-defined rules to determine whether the distributor system stored in a database, wherein said distributor system is interested in the content specified by said provided information (see at least: 892u 8, 18; 892v 12-14; 892w Page 8, 13-14; 892x 7).

providing, by said distributor system, the response to said publishing system and determining by said publishing system, whether the response indicates that the distributor system is interested in the content specified by said provided information (see at least:)0892v 12-14). The Examiner notes that once content is approved it is distributed. The iUniverse publishing and distribution system provides approval (i.e. a response indicating interest) for the provided content, and may do so on the basis that a work is not hate or pornographically related.

only if said publishing system determines that the distributor system is interested in the content specified by said provided information, supplying, by said publishing system, metadata and rights specification to said distributor system, said metadata including identification and descriptive data of said content, and said rights specification including at least one of usage rights and rights conditions (see at least: 892v 13; 892x 8; 892w 7-10). Despite this teaching, the Examiner notes that methods are composed of actions/steps. Accordingly, once the actions/steps that are positively recited of a method is satisfied, the method as a whole is satisfied regardless of whether or not other steps that are alternative steps or conditionally invocable (e.g. “if” and “only if”) under certain other hypothetical scenarios are satisfied. The Examiner further notes that the limitation “*only if said publishing system determines...*” is conditionally invocable and does not move to distinguish the claimed invention from the references.

892u-892y teach all of the above as noted and further teach a publishing system and a distribution system together as parts of the iUniverse web system/service operating singly as the claimed invention (i.e. a single, overall system with the same operation). 892u-892y, however, do not expressly teach the individual systems separately. In regards to the rearrangement of parts (i.e. rearrangement of the two systems into a single system), claims that read on prior art except with regard to the positioning and arrangement of parts are held unpatentable if the shifting of those parts would not have modified the operation of the device [*In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)]. With respect to claim 147, Japikse is applicable because the differences in the claimed invention and the invention demonstrated by 892u-892y is

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merely in the arrangement of parts (i.e. the systems themselves). More particularly, 892u-892y shows communication between different sub-systems of the iUniverse web service. Simply rearranging these subsystems into separated, distinct systems of their own only results in a separation of those systems and does not modify the mode of operation for the sub-systems. Though 892u-892y teach the individual systems embodied in a single system, it would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of 892u-892v to have separated a publishing system and distribution system into distinct systems as demonstrated by Japikse in order to provide for state of the art on-demand publishing, printing, and distribution partnerships allowing titles to be available in thousands of bookstores such as Barnes and Noble (see at least: 892u, 14; 892v, 3; 892x, 4, 130) because the placement of the systems is a matter of design choice and does not patentably define the claims over the cited art (see *Japikse*). Additionally, applicant has not persuasively demonstrated the criticality of providing the disclosed arrangement versus the arrangement disclosed by iUniverse.

Regarding claim 148-149, 892u-892y teach:

(148) wherein the distributor system further uses pre-defined rules to perform at least one of narrowing the rights defined by the rights specification and changing conditions defined by the rights specification, resulting in customized rights to offer a rights consumer (see at least: 892w Pages 7-11).

(149) *wherein the pre-defined rules comprise at least one of content type preferences, rights and conditions, preferences, content topics and publishers (see at least: 892u 18; 892v 12; 892w Pages 7-14).*

Regarding claim 153 and 155-157, 892u-892y teach:

(153) *wherein the rights specification includes at least one of the right to print, view, play, extract, and export (see at least: 892w Pages 7-11; 892x 8).*

(155) *creating, by the publishing system, the rights specification (see at least: 892u 18; 892v 12; 892w Pages 7-14).* The Examiner notes that the policies created for content are designated/created by the iUniverse system.

(156) *wherein the rights specification is created, based upon at least one of a user profile, a default rights specification, inference rules, and an analysis of the selected content (see at least: 892u 18; 892v 12; 892w Pages 7-14).*

(157) *wherein the rights specification includes at least one usage right and a condition upon which the usage right is contingent (see at least: 892u 18; 892v 12; 892w Pages 7-14).*

Regarding claim 195, 892u-892y teaches wherein the rights specification includes information regarding the specific rights granted to the content if a given set of conditions is satisfied (see at least: 892y 13). The Examiner notes that if a work fits into a specific category.

Regarding claims 199-201, 205, 207-209, and claims 247 and 249, the limitations set forth these claims closely parallel the limitations set forth in claims 147-149, 153, 155-157, and 195. Claims 199-201, 205, and 207-209, as well as claims 247 and 249, are thereby rejected under the same rationale.

Response to Arguments

3. Applicant's arguments with respect to claims 147-149, 153, 155-157, 195, 199-201, 205, 207-209, 247, and 249 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

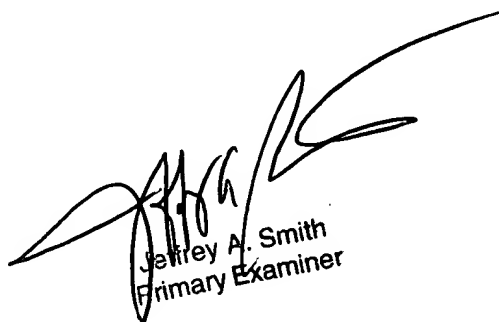
- US 6012890 A discloses an electronic bookstore vending machine
- US 7043488 B1 discloses a method and system for storing hierarchical content objects in a data repository
- US 6466920 B1 discloses a method and system for preventing illegal use of digital contents, processing program thereof, and recording medium for the program
- US 6578008 B1 discloses a method and system for an online talent business
- PTO 892 reference Z discloses iUniverse as a one stop shop for writers

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Fadok can be reached on (571) 272-6755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
June 22, 2006



Jeffrey A. Smith
Primary Examiner